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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

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Applicant's or agent's file reference PSIC068WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)	
International application No. PCT/EP 03/05149	International filing date (day/month/year) 16.05.2003	Priority date (day/month/year) 08.07.2002
International Patent Classification (IPC) or both national classification and IPC G06K5/02		
Applicant SICPA HOLDING S.A. et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 6 sheets, including this cover sheet.
- ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).
- These annexes consist of a total of 3 sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 19.11.2003	Date of completion of this report 01.10.2004
Name and mailing address of the International preliminary examining authority:  European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer Bhalodia, A Telephone No. +49 89 2399-7779 

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP 03/05149

I. Basis of the report

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

Description, Pages

1-14 as originally filed

Claims, Numbers

1-18 received on 01.09.2004 with letter of 30.08.2004

Drawings, Sheets

1/2-2/2 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

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5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	1-18
	No: Claims	-
Inventive step (IS)	Yes: Claims	-
	No: Claims	1-18
Industrial applicability (IA)	Yes: Claims	1-18
	No: Claims	-

2. Citations and explanations

see separate sheet

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Re Item V

Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1). Reference is made to the following documents:

D1: FR-A-2 754 371
D2: EP-A-0 997 837
D3: JP(A) 63 007955
D4: DE 100 12 361
D5: GB-A-2 240 510

D6: WO 9513597

The document D6 was not cited in the international search report. A copy of the document is appended hereto.

2). The application does not meet the requirements of Art. 6 PCT, because **claim 1** is not clear:

The term "continuous process" used in claim 1 is vague and unclear and leaves the reader in doubt as to the meaning of the technical features to which it refers, thereby rendering the definition of the subject-matter of said claim unclear.

3). The document D1 is regarded as being the closest prior art to the subject-matter of **claim 1**, and discloses (the references in parentheses applying to this document):

A method for marking an item (récépissé), comprising the steps of:

- a) providing information to be applied to the item (page 4, lines 30-35);
 - b) applying a first marking to the item corresponding to the information provided in step a) (page 5, lines 1-6)
 - c) reading said first marking applied in step b) (page 5, lines 9-11) and comparing it with the information provided in step a) (page 5, lines 12-14)
 - d) applying a second marking to the item if the first marking read in step c) does not correspond to the information provided in step a) (page 5, lines 19-22);
- wherein said first marking, said reading of said first marking, and said second marking are performed in a continuous process.

D1 does not disclose the printing in covert.

The problem to be solved by the present invention may therefore be regarded as increasing the security of the item against counterfeit reproduction.

The solution proposed in **claim 1** of the present application cannot be considered as involving an inventive step because it is known from D6 (p.15, l.1-6) to print in covert (with invisible ink) an item (voucher, lottery ticket, brand protection label...) to increase security and reduce risk of counterfeiting. In order to impede reproduction by counterfeiters of the item of D1, the man skilled in the art would introduce an invisible ink such as disclosed in D6.

It is a general knowledge, for protecting a document, label, ticket or banknote against reproduction, to introduce an anti-counterfeit feature such as invisible ink, watermark, hologram...

D1 also discloses a "continuous process", the first marking, reading of first marking and printing of second marking are steps automatically processed one after the other (p.5, l.1-22). The medium printed in D1 is a roll of paper (p.3, l.26-27) and it should also be noted that papers consist of several layers, one layer can be considered as a carrier.

Even on the assumption that D1 does not disclose a continuous process of several items, printing labels in a continuous manner in order to produce a large number of labels is very well known, cf. D5 (p.4, l.1-4) which also discloses labels on a carrier.

As written in the previous communication (02.06.2004), "printing the marking in covert" and "affixing the item to a carrier to perform a continuous process" solve different problems not directly linked. The corresponding features are considered to be a juxtaposition of features without functional relationship (Guidelines C-IV-Annexe 2.1).

Therefore the subject-matter of **claim 1** does not involve an inventive step in the sense of Article 33(3) PCT.

- 4). The same reasoning applies, mutatis mutandis, to the subject-matter of the corresponding independent **claim 16**, which therefore is also considered not inventive.

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- 5). Dependent **claims 2-15,17-18** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step, see documents D1-D4 and the corresponding passages cited in the search report.
- 6). The claims should have been drafted in the two-part form in accordance with Rule 6.3(b) PCT, which in the present case would have been appropriate, with those features known in combination from the prior art being placed in the preamble (Rule 6.3(b)(i) PCT) and with the remaining features being included in the characterising part (Rule 6.3(b)(ii) PCT).

To meet the requirements of Rule 5.1(a)(ii) PCT, the documents D1-D6 should have been identified in the description and the relevant background art disclosed therein should have been briefly discussed.

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